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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,117	10/02/2000	Jay S. Walker	00-047	3707
22927	7590	08/02/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			FRENEL, VANEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,117

Applicant(s)

WALKER ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11, 12, 14, 15, 26, 27, 32, 33, 59, 60, 62, 63, 74, 75, 80 and 81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 12, 14, 15, 26, 27, 32, 33, 59, 60, 62, 63, 74, 75, 80 and 81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Restriction filed on 04/18/05. Claims 1-7, 11-12, 14-15, 26-27, 32-33, 59-60, 62-63, 74-75 and 80-81 have been elected and presented for examination. Claims 1-7, 11-12, 14-15, 26-27, 32-33, 59-60, 62-63, 74-75 and 80-81 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-7, 11-12, 14-15, 26-27, 32-33, 59-60, 62-63, 74-75 and 80-81 because the claimed invention is directed to non-statutory subject matter.

(A) The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claim 1 recites "a method for providing a benefit to a customer" but do not clearly and definitely utilize any technological device in performing the various claimed steps.

In the present case, claim 1 does not recite any technological device (i.e., "a computer or a computer readable medium" tying with the body of the claim in performing the various steps of "processing" within the computer system.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claim 1 as a whole is directed to a method for determining a preventative treatment for the customer.

As such, this invention produces a useful, concrete, and tangible results as offering a benefit to the customer for the transaction if the customer adopts the preventative treatment.

Claims 2-7, 11-12, 14-15, 26-27, 32-33, 59-60, 62-63, 74-75 and 80-81 do not recite any application or use of the technological arts, and thus equally rejected under 35U.S.C. 101.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhler et al (6,077,193) in view of Brown (6,210,272).

(A) As per claim 1, Buhler discloses a method for providing a benefit to a customer, comprising: receiving an identification of a customer involved in a transaction with a third party (See Buhler, Col.1, lines 15-23)

Buhler does not explicitly disclose determining a preventative treatment for the customer; and offering a benefit to the customer for the transaction if the customer adopts the preventative treatment.

However, this feature is known in the art, as evidenced by Brown. In particular, Brown teaches determining a preventative treatment for the customer (See Brown, Col.7, lines 24-67 to Col.8, line16); and offering a benefit to the customer for the transaction if the customer adopts the preventative treatment (See Brown, Col.7, lines 24-67 to Col.8, line 16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system of Buhler with the

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motivation of providing a method that facilitates social interaction and discussion about health and self-care (See Brown, Col.1, lines 65-67).

(B) As per claim 2, Brown discloses the method wherein the receiving further comprises receiving the identification from at least one of: the customer, a merchant, a web site operator, an acquaintance of the customer, a family member related to the customer, a doctor, a pharmacist, an insurance provider, and a government agency (See Brown, Col.7, lines 46-50).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Brown discloses the method wherein the identification comprises at least one of: a unique identifier associated with the customer and a name of the customer (See Brown, Col.7, lines 46-50).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Buhler discloses the method wherein said customer is involved in a transaction comprising at least one of: a purchase of a product, a purchase of a service, an insurance premium, and an online purchase (See Buhler, Col.2, lines 30-39).

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(E) As per claim 5, Brown discloses the method wherein the customer has profile information comprising at least one of: an age of the customer, a gender of the customer, a geographic location corresponding to a residence of the customer, a medical history of the customer, a medical history of the customer's family, an occupation of the customer, a previous preventative treatment adopted by the customer, and at least one preventative treatment not adopted by the customer (See Brown, Col.3, lines 1-10).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Brown discloses the method wherein the preventative treatment further comprises at least one of: a preventative health treatment, a preventative automobile repair, and a preventative home maintenance repair (See Brown, Col.1, lines 55-64).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Brown discloses the method wherein the preventative health treatment comprises at least one of: a blood test, a cancer screening, a blood pressure screening, a teeth-cleaning treatment, a mammogram, a pap smear, a sigmoidoscopy, a colonoscopy, an immunization, a psychiatric examination, a psychological

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examination, a dental examination and a physical examination (See Brown, Col.5, lines 54-67).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(H) As per claim 11, Brown discloses the method wherein said determining a preventative treatment further comprises determining a plurality of preventative treatments, the method further comprising: comprising a cost associated with each of said plurality of preventative treatments (See Brown, Col.1, lines 15-61); and selecting at least one of said plurality of preventative treatments based on said comparing (See Brown, Col.4, lines 1-30).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(I) As per claim 12, Buhler discloses the method wherein said selecting further comprises: selecting a preventative treatment having a lowest cost (See Buhler, Col.1, lines 54-57).

(J) As per claim 14, Buhler discloses the method further comprising: determining a future cost for the at least one condition, wherein the future cost is determined based on a probability of the customer contracting the condition (See Buhler, Col.1, lines 25-61).

(K) As per claim 15, Buhler discloses the method further comprising: determining a future cost for the at least one condition, wherein the future cost is determined based on a probability of the customer contracting the condition within a predetermined time (The Examiner interprets elapsed time to be a predetermine time See Buhler, Col.4, lines 56-67 to Col.5, line 7).

(M) As per claim 26, Brown discloses the method wherein the predetermined condition comprises a determination that the preventative treatment was adopted (See Brown, Col.3, lines 20-33).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(N) As per claim 27, Buhler discloses the method wherein the predetermined condition comprises a determination that the preventative treatment was adopted within a predetermined time (The Examiner interprets elapsed time to be a predetermine time See Buhler, Col.4, lines 56-67 to Col.5, line 7).

(O) As per claim 32, Buhler discloses the method wherein the benefit is provided to the customer (See Buhler, Col.1, lines 15-50).

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(P) As per claim 33, Brown discloses the method wherein the benefit is provided to the customer after receipt of a confirmation that the preventative treatment has been adopted (The Examiner interprets reward to be a form of receipt of a confirmation See Brown, Col.8, lines 1-13).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(Q) As per claim 59, Brown discloses the method wherein said determining a preventative treatment further comprises determining a plurality of preventative treatments, the method further comprising: comparing a future cost associated with each of said plurality of preventative treatment (See Brown, Col.1, lines 15-61); and selecting at least one of said plurality of preventative treatments based on said comparing (See Brown, Col.4, lines 1-30).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(R) As per claim 60, Buhler discloses the method wherein said selecting further comprises: selecting a preventative treatment having at least one of: (Buhler teaches a lowest cost See Buhler, Col.1, lines 54-57).

(S) As per claim 62, Brown discloses the method wherein the future cost is determined based on a probability of the customer contracting the condition (See Brown, Col.7, lines 16-31).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(T) As per claim 63, Buhler discloses the method wherein the future cost is determined based on a probability of the customer contracting the condition within a predetermined time (The Examiner interprets elapsed time to be a predetermine time See Buhler, Col.4, lines 56-67 to Col.5, line 7).

(U) As per claim 74, Brown discloses the method wherein the predetermined condition comprises a determination that the preventative treatment was adopted (See Brown, Col.3, lines 20-33).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(V) As per claim 75, Buhler discloses the method wherein the predetermined condition comprises a determination that the preventative treatment was adopted within a predetermined time ((The Examiner interprets elapsed time to be a predetermine time See Buhler, Col.4, lines 56-67 to Col.5, line 7).

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(W) As per claim 80, Buhler discloses the method wherein the benefit is provided to the customer (See Buhler, Col.1, lines 15-50).

(X) As per claim 81, Brown discloses the method wherein the benefit is provided to the customer after receipt of a confirmation that the preventative treatment has been adopted (The Examiner interprets reward to be a form of receipt of a confirmation See Brown, Col.8, lines 1-13).

The motivation for combining the respective teachings of Buhler and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches physical exercise video system (5,591,104).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
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June 21, 2005


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